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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,686	12/03/2001	Adriano Huber	216597US2PCT	9492

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EXAMINER
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BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/926,686

Applicant(s)

HUBER ET AL.

Examiner

Bradley Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 1-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/3/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-22 are presented for examination on the merits.

#### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the elements of the invention as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

The claims are objected to because they include reference characters may not delineate reference characters with specificity, e.g., applicant denotes (7) as the first key, (7') as an

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encrypted first key and (7") as a stored decrypted first key. The applicant should delineate reference characters with specificity so as to avoid confusion and provide the utmost clarity in claiming each element of the invention.

Claims 1-22 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim *should refer to other claims in the alternative only, and/or cannot depend from any other multiple dependent claim*. See MPEP § 608.01(n). For instance, claims 7, 8, 10, 11 and so forth depend on multiple dependent claims.

Claims 1-22 are further objected to because of the following informalities: the applicant's wording and sentence structure is redundant and confusing and fails to clearly indicate the elements of each claim. Applicant should avoid using unnecessary terms such as "in which method" or provide examples within a claim. Also, the applicant's uses of the term "indications" throughout tend to be vague and confusing.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (hereinafter Downs), U.S. Patent 6,226,618 B1 in view of Hannula et al. (hereinafter Hannula), U.S. Patent 6,366,893 B2.**

As per claim 1, Downs discloses a method for ordering and transmitting of digital objects stored and transmitted from a database center and received by a user for playback of the media content either through purchase or licensing via a network communications center (figures 1A-D; columns 6-8). Although Downs does describe wireless and mobile devices used in such transactions, it fails to explicitly disclose such transfer of digital media via a mobile communications terminal. Hannula, however, teaches a system, method and apparatus of performing electronic payment transactions between a mobile terminal and a gateway service center to utilize or purchase digital media objects by a user (figures 2-6 and associated text). It would have been obvious to one of ordinary skill in the art at the time of the invention, to utilize the method of transfer and purchase of digital data via a mobile device to carryout and augment the electronic content delivery system described in Downs, as more users in the digital transfer technology are utilizing mobile phones and devices for various other modalities foreseeable in the art.

As per claim 2, Downs further discloses the method of claim 1 wherein media content is encrypted utilizing a first key and decryption means for playback of the media objects (figure 1D and associated text).

As per claim 3, Downs further discloses the method of claim 2, wherein media objects stored in a communications terminal are selected and transmitted to another communication terminal, while the media content remains encrypted (figures 3-4 and associated text).

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As per claim 4, Downs further discloses one of the claims 2 or 3, wherein the first key assigned to the media content is transmitted encrypted by means of a public second key to the respective communications terminal and is decrypted by means of a private third key (figure 6 and associated text).

As per claim 5, Downs further discloses the method of claim 4, wherein data about conditions of use for the media object are also sent to the communications terminal separately or together with the first key assigned to this media object (figure 6 and associated text).

As per claim 6, Downs further discloses the method of claims 4 or 5, wherein for decryption of the media content of the media object, the decrypted first key assigned to this media object is transmitted in a protected way to a decryption module of the communications terminal (columns 12-14).

As per claim 7, Downs further discloses the method of claims 1 to 6, wherein the media objects contain in each case indications about the center where the respective media object can be obtained (figure 1B and associated text).

As per claim 8, Downs further discloses the method of claims 2 to 7, wherein the media objects contains in each case indications about a key server from which the encrypted first key can be obtained (figures 2-5 and associated text).

As per claim 9, Downs further discloses the method of claim 8, wherein a key obtaining module of the respective communications terminal automatically requests, receives and stores the encrypted first key in each case from the key server (figure 12 and associated text).

As per claim 10, Downs further discloses the method of claims 1 to 9, wherein the media objects contain in each case indications concerning the media content of the media object, for example price information, title indications, playing duration or a sample playback (columns 48-49).

As per claim 11, Downs further discloses the method of claims 1 to 10, wherein as payment for the playback of the media content of the media object a monetary amount assigned to this media object is debited against a prepaid monetary amount stored on a chipcard of the respective communications terminal (columns 75-76).

As per claim 12, Downs further discloses the method of claims 1 to 11, wherein the number of playbacks of said media content of the media object is counted in the respective communication terminal and this number is transmitted to a license server (columns 59-60).

Claims 13-22 are directed to a device or terminal of the above claimed method and are therefore rejected on the same grounds (see above).

*Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations*

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*are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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